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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,418	03/31/2004	Omar Habib Khan	24207-10074	5742

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EXAMINER	
HOANG, PHUONG N	

ART UNIT	PAPER NUMBER
2194	

MAIL DATE	DELIVERY MODE
05/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/814,418	KHAN ET AL.	
	Examiner	Art Unit	
	Phuong N. Hoang	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 4 - 26, 29 - 53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4 - 26, 29 - 53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims *1, 4 - 26, 29 - 53* are pending for examination.

2. This office action is in response to amendment filed 2/27/07.

3. References, not found in this office action, can be found in previous office action.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 26, 52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 21 of copending Application No. 10/814,317 (refer as 317). Although the conflicting claims are not identical, they are not patentably distinct from each other because both

computer systems comprise substantially the same elements. The differences between the patent no. 317 and this case are the score, and updating access information for the article associated with the event. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize the score would show the duplicate events and the data has to be update after indexing.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 30, 33, 40, 43, 50, 53, 63, 66, 89, 92, 99 of copending Application No. 10/814,357 (refer as 357). Although the conflicting claims are not identical, they are not patentably distinct from each other because both computer systems comprise substantially the same elements. The differences between the patent no. 357 and this case is the event having an associated article. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that an event is generated by an user action on an browser.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 26 – 50, 52 – 53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. As to claim 26, it is not limited to storage embodiments. In view of applicants' disclosure, specification paragraph [0013], the medium is not limited to storage embodiments, instead being defined as including both tangible embodiments (CD-ROM, tape) and intangible embodiments (wireless). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. Examiner suggests applicant changes to "computer storage medium" to only refer to storage embodiments.

10. As to claim 27 – 50, they are dependent claims of claim 26. They do not support the deficiency of claim 26. Therefore, they are rejected for the reason above.

11. As to claim 52, it merely recites a system comprising event, capture score, threshold value. These components are software components, i.e., computer program per se. Such claimed matter, which is non-functional descriptive material per se, is not statutory because it is not a physical "thing" nor a statutory process as there are not "act" being performed.

12. As to claim 53, it is dependent claim of claim 53. It does not support the deficiency of claim 53. Therefore, it is rejected for the reason above.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. **Claims 1, 11 – 17, 26, 36 – 42, 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Payton, US parent no. 6,681,247 in view of Harris, Us pub. no. 2002/0091972.**

15. **As to claim 1**, Payton teaches a method, comprising:

identifying an event having an associated article (monitor event of user action on the computer desktop browsing items, folders, bookmarks, figures 1 and 2 and associated text);

identifying article data (data items or information) associated with the article; and

determining a capture score (entry processor select matching items) for the event based at least in part on the article data.

Payton does not teach compiling event data associated with the event at least in part to a comparison of the capture score and the threshold value.

Harris teaches compiling the event data at least in part to a comparison of the capture score and the threshold value (events .... Predefined threshold, 0040).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Dayton and Harris's system because Harris's compiler would adjust the actions based on the results of comparison (0040).

16. **As to claims 11 - 13**, Payton teaches wherein the article data comprises access data associated with the article (col. 9 lines 55 – col. 10 lines 5).

17. **As to claim 14,** Payton teaches wherein the capture score is determined at least in part by associating at least one weight with the article data (col. col. 9 lines 55 – col. 10 lines 5).

18. **As to claim 15**, Dayton teaches wherein the weight is determined at least in part by user behavior(col. 7 lines 15 – 25).

19. **As to claims 16 - 17**, Payton teaches determining a threshold value (chosen threshold value, col. 11 lines 1 – 5).

20. **As to claim 26**, this is the medium claim of claim 1. See rejection for claim 1 above.

21. **As to claim 36 - 40**, see rejection for claims 11 – 15 above.

22. **As to claims 41 – 42,** see rejection for claims 16 – 17 above.

23. **As to claim 49,** see rejection for claim 24 above.

24. Claims 4 - 10, 23 - 25, 29 – 35, 48, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton, US parent no. 6,681,247 247 in view of Harris, Us pub. no. 2002/0091972, and further in view of Dacosta, US patent no. 6,826,553.

25. **As to claim 4**, Dacosta teaches wherein a capture score is determined at least in part by associating a weight with one or more fields of an event schema (match structure attributes in xml schema files, col. 13 lines 25 – col. 14 line 35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Dayton and Dacosta's system because Dacosta's xml schema would provide the document definition for matching articles or web pages against the key words search to return the results.

26. **As to claims 5 – 6, 8 - 9**, Dacosta teaches wherein the article data comprises a location, file type, of the article (col. 5 lines 20 – 25, col. 13 lines 30 – 40).

27. **As to claims 7, 10**, Dayton teaches the weight is determined at least in part by user behavior (col. 7 lines 15 – 25).

28. **As to claim 23**, Dacosta teaches wherein the location of the article can comprise a directory identifier in which the article is stored (col. 13 lines 25 – col. 10 lines 10).

29. **As to claim 24**, Dacosta teaches wherein the article is identified during a crawl of a client device (col. 7 lines 15 – 25).

30. **As to claim 25**, Dacosta teaches determining if the article meets at least one criterion and not capturing the event if the article meets the criterion (col. 3 lines 32 – 50).

31. **As to claims 29 - 35,** see rejection for claims 4 - 10 above.

32. **As to claims 48 and 50,** see rejection for claims 23 and 25 above.

33. Claims 18 – 22, 43 – 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton, US parent no. 6,681,247 US parent no. 6,681,247 247 in view of Harris, Us pub. no. 2002/0091972, and further in view of Paine, US Pub. no. 2003/0055816.

34. **As to claims 18 – 21**, Paine teaches indexing the event if the capture score is above or below the threshold value (threshold may be variable because it depends on how many pages are indexed on the www, 0116).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Payton and Paine's system because Paine's indexing with flexibility of the threshold value would enable the indexing no matter how many users conducting search for articles on the world wide web.

35. **As to claim 22**, Paine teaches wherein the event is a historical event (history, 0058,0064).

36. **As to claims 43 and 46,** see rejection for claims 18 and 21 above.

37. **As to claim 47**, see rejection for claim 22 above.

38. Claims 51 - 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dacosta, US patent no. 6,826,553 in view of Paine, US Pub. no. 2003/0055816.

39. **As to claim 51**, Dacosta teaches a method, comprising:

identifying an event having an associated article (monitor user-generated event access web pages, col. 7 lines 15 – 55) by crawling a client device;

identifying one or more of a location of the article, a file type of the article, and access data for the article (criteria-base matches .... Location, structure attributes, col. 5 lines 15 – 25, col. 6 lines 1 – 10, col. 13 lines 25 – col. 14 lines 30);

determining a capture score (the first 5 matches, col. 10 lines 27 – 55) for the event based at least in part on one or more of the location of the article, the file type of the article, and the access data for the article.

While Dacosta teaches the index (source index, col. 13 lines 15 – 22). Dacosta does not explicitly teach indexing the event if the capture score is above a threshold value.

Paine teaches indexing the event if the capture score is above or below the threshold value (threshold may be variable because it depends on how many pages are indexed on the www, 0116).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Payton and Paine's system because Paine's indexing with flexibility of the threshold value would enable the indexing no matter how many users conducting search for articles on the world wide web.

40. **As to claim 52**, Dacosta teaches determining a capture score (the first 5 matches, col. 10 lines 27 – 55) for an event.

While Dacosta teaches the index (source index, col. 13 lines 15 – 22). Dacosta does not explicitly teach indexing the event if the capture score is above a threshold value.

Paine teaches indexing the event if the capture score is above or below the threshold value (threshold may be variable because it depends on how many pages are indexed on the www, 0116).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Payton and Paine's system because Paine's indexing with flexibility of the threshold value would enable the indexing no matter how many users conducting search for articles on the world wide web.

41. **As to claim 53**, Paine teaches storing (col. 4 lines 10 – 55) the event if the capture score is above the threshold value.

Response to Arguments

42. Applicant's arguments with respect to claims 1 – 50 under 35 U.S.C. 102 and 103 rejection, have been considered but are moot in view of the new ground(s) of rejection; with respect to claims 51 – 53 under 35 U.S.C. 103 rejection, have been fully

considered but they are not persuasive; regarding to claims 26 – 53 under 35 U.S.C. 101, have been fully considered but they are not persuasive.

43. Applicant argued that indexing is one way of compiling. In response, indexing and compiling are different concepts.

44. Regarding to 101 rejection. "Tangible medium" can not overcome 101 rejection. It has to be "storage medium" as suggested in previous office action. A computer-implemented system claimed in the pre-amble, however, there is no hardware in the body to execute the claimed system. It needs a hardware, such as a processor, to execute the system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong N. Hoang whose telephone number is (571)272-3763. The examiner can normally be reached on Monday - Friday 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on 571-272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ph
May 13, 2007

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER